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GROUP 3700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Patent Application
SN: 09/747,000
Filed: 12/21/2000
By: John D. Watts
For: Threaded Pipe Connection Method

Art Unit: 3726
Examiner: Trinh T. Nguyen

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sent fax (703) 872-9303

REQUEST TO WITHDRAW FINAL REJECTION
IN RESPONSE TO OFFICE ACTION MAILED 04/15/2003

Applicant respectfully requests that examiner withdraw the Final Rejection as being Premature, for reasons explained as follows:

CLAIM 1 STANDS REJECTED UNDER 35 USC 102(b) AS BEING ANTICIPATED BY
CARLIN US 4,838,068.

1. "The reference must teach the entire claim." [Beckman Instruments v LKB Produkter AB, 892 F.2d 1550 II lines 7-16, fourth par. 13 USPQ2d]

Nowhere does Carlin Patent '068 suggest a method of machining a pipe end, then swaging a portion of the pipe wall, and then finish machining a thread on the swaged portion.

2. "If even a single element or limitation required by patent claim is missing from disclosure of prior art reference, there can be no anticipation." [35 USCA 102 Ferag AG v Grapha-Holding AG 905F.Supp.1.]

Nowhere does Carlin '068 disclose machining the pipe end prior to swaging.

3. "---absence of even single claim limitation precludes finding that prior art reference anticipates claim." [Endress + Hauser v Hawk Measurements Sys. 892 F.supp.1107, affirmed 122 F.3 1040.]

Nowhere does Carlin '068 swage a wall of reduced thickness.

4. "---anticipation requires that the same invention, including each element and limitation of the claims, was known or used by others---" [Oney v Ratiff 182 F.3d 893]

No such proof is in the record, though the art of pipe manufacture is centuries old.

CLAIMS 2, 6-9, AND 20 STAND REJECTED UNDER 35 USC 103(a) AS BEING (obvious)
UNPATENTABLE OVER CARLIN US 4,838,068.

5. In 35 USCA #103, 282 states the following: (A) That challenger prove by clear and convincing evidence that claims would have been obvious to person of ordinary skill in the art, which requires inquiry into the scope and content of the prior art; differences between prior art and

claims at issue, and the level of ordinary skill in the art. (B) The issue of obviousness is determined entirely with reference to hypothetical person having ordinary skill.

Page 4 lines 3-16 describe some advantages of the present invention not enjoyed during 200 years of prior art. No practitioner of ordinary skill, or even of extreme skill, has practiced the present invention during the last 200 years. To untold thousands of highly skilled practitioners, the present invention was not obvious.

6. Evidence that it would have been "obvious to try" given invention is insufficient to support finding of patent invalidity due to obviousness. 35 USCA #103 [LNP Engineering v Miller Waste Mills, UD Dist. Ct., Civ. 96-462-RRM]

7. "One cannot rely on hindsight in determining whether an invention was obvious."
[35 USCA #103.]

Although the art is 200 years old, the "long felt need" was not satisfied before disclosure of the present invention.

Applicant hereby requests that the examiner withdraw the Final Rejection, reconsider the application and pass all claims to issue.

Respectfully submitted,


John D. Watts

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8301 Guthrie, Austin, Tx 78750-7852
(512) 418-8668 fax (512) 418-8633

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